

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

EOLAS TECHNOLOGIES
INCORPORATED,

Plaintiff,

v.

AMAZON.COM INC,

Defendant.

Case No.17-cv-03022-JST (JSC)

**ORDER RE: *IN CAMERA* REVIEW FOR
VIOLATION OF PATENT
PROSECUTION BAR**

The Court has completed its review of Plaintiff Eolas Technologies Inc.'s *in camera* production. The district court ordered the production in response to Defendant Amazon System Inc.'s order to show cause regarding McKool Smith's (Eolas's counsel) alleged violation of the patent prosecution bar imposed in the parties' earlier filed action in the Eastern District of Texas. *See Eolas Techs., Inc. v. Adobe Sys., Inc.*, No. 6:09-CV-446 LED, Dkt. No. 423 (E.D. Tex. Sept. 28, 2010)(filed here at Dkt. No. 262-2). The district court then referred the dispute to the undersigned magistrate judge. The Court sets a hearing on the matter for February 1, 2018 at 9:00 a.m. in Courtroom F, 450 Golden Gate Ave. San Francisco, California. The Court also orders the following:

First, the vast majority of documents in Eolas's production are not privileged. Eolas has inexplicably claimed attorney-client and/or work-product privilege over a plethora of non-confidential public documents from the parties' earlier action in the Eastern District of Texas

1 simply because these documents were attached to an email which it contends is privileged. The
2 attorney-client privilege protects from discovery “*confidential* communications between attorneys
3 and clients, which are made for the purpose of giving legal advice.” *United States v. Richey*, 632
4 F.3d 559, 566 (9th Cir. 2011) (emphasis added). Similarly, the attorney work-product doctrine,
5 codified in Federal Rule of Civil Procedure 26(b)(3), protects “from discovery documents and
6 tangible things prepared by a party or his representative in anticipation of litigation.” *Admiral Ins.*
7 *Co. v. United States Dist. Court for the Dist. Ariz.*, 881 F.2d 1486, 1494 (9th Cir. 1989).
8 Accordingly, on or before January 18, 2018, Eolas shall produce these non-confidential
9 attachments and produce an updated privilege log, or file a brief explaining how it can claim
10 attorney-client or work-product privilege over publicly filed briefs (*see e.g.*, Privilege log entries
11 25, 26, 27, 28, 74-77, 136-139, 319, 320, 329, 330, 332, 333, 342, 343); trial transcripts (*see e.g.*,
12 Privilege log entries 294, 296, 308, 312-317, 322-327, 335-340); expert reports exchanged in the
13 prior action between the same parties to this action (*see e.g.*, Privilege log entries 30, 36, 55, 78,
14 83, 100, 104, 140, 145, 181, 198, 214); and claim charts from the prior action (*see e.g.*, Privilege
15 log entries 38-51, 83-98, 147-160, 167, 168-180, 184-197, 200-213).


16 Second, Eolas concedes that the privilege log it provided the Court differs from the
17 privilege log Eolas previously served and which Amazon heavily relied upon in its order to show
18 cause, and that the current log excludes certain documents which Amazon relied on as a basis for
19 its order to show cause. On or before January 18, 2018, Eolas shall submit to the Court for *in*
20 *camera* review any documents which it has omitted from its recent log and its *in camera*
21 production from the January 1, 2014-July 22, 2014 timeframe which would include EOLASPRIV-
22 CK00328 through EOLASPRIV-CK00421. (Dkt. Nos. 262-10 at 33, 262-20 at 33.)

23 Finally, at the February 1, 2018 hearing, the parties should be prepared to discuss Eolas’s
24 document production, Eolas’s assertion of privilege, and the alleged violation of the patent
25 prosecution bar. Eolas shall be prepared to respond to questions regarding particular
26 communications and thus shall have a paper or electronic version of its production with it at the
27 hearing. In addition, both sides shall be prepared to discuss the possible remedy if the Court were
28 to conclude that there was a violation of the patent prosecution bar for the pre-July 22, 2014 time

period, post-July 22, 2014 time period, or both.

IT IS SO ORDERED.

Dated: December 21, 2017


JACQUELINE SCOTT CORLEY
United States Magistrate Judge